

Application No. 10/748,354
Amdt. dated November 29, 2005
Reply to Office Action of October 31, 2005

054030-0045

REMARKS/ARGUMENTS

The present application was originally filed with claims 1-14. Following entry of Applicants election and traverse set forth herein, claims 9-13 are withdrawn.

RESTRICTION AND ELECTION WITH TRAVERSE

In response to the restriction requirement mailed October 31, 2005, Applicants elect for further prosecution Group I, claims 1-8 and 14, directed to a transgenic mouse which displays a reduced heart rate as compared to a negative transgenic offspring.

RESTRICTION

While the Applicants have made the required election, the restriction requirement is believed improper and respectfully traversed. "[I]f the search and examination of all the claims of an application can be made without serious burden the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." MPEP 803. Accordingly, Applicants submit that no undue burden is placed on the Office in examining the subject matter of Groups I and II because any search of the patent and non-patent literature describing the subject matter of Group I, will include a search of the literature describing the subject matter of Group II.

Specifically, the elected claims are directed to a transgenic mouse and require a search of the art directed to transgenic animals which, by definition are created by transforming the germ line of a host animal with a nucleic acid expressing the limitations recited in claims 1-5. These limitations are repeated in claiming the nucleic acid recited in nonelected claims 9-13. Thus, a search of the art in the field of the claims characterized as Group I will include a search of the art in the field of Group II. Each is

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coextensive with the other. Thus, the Office cannot perform a search of either of the claims identified as Groups I and II without completing a search of the other.

Further, Applicants point out that claim 14, elected Group I, recites the production of a transgenic mouse by introducing a nucleic acid molecule according to claim 9. Thus, search of the subject matter of claim 14, must, *ex facie*, include a search of the subject matter of claim 9. Therefore, the Office cannot perform a search of claim 14, Group I without completing a search of the subject matter of Group II.

In the present instance, without taking any position on the patentable distinctness of the subject matter identified as Groups I and II, the search and examination of the claims identified as Group I and Group II neither imposes a serious burden on the Office nor can a search of the elected claims be undertaken without concomitantly performing a search on the subject matter of the non-elected claims. Further, the respective claims are linked such that they are inseparable. Therefore, the requirement for restriction between the claims of Groups I and II is improper and should be withdrawn.

Finally, Applicants reserve their right as articulated by the Federal Circuit in *In Re Ochiai* and *In re Brouwer* to seek rejoinder of claims not elected when those claims relate to a process of making or using nonobvious products in accordance with the provisions of MPEP 809.04 and 821.04. Therefore, upon allowance of the elected claims, Applicants request a review of the Restriction Requirement and Election of Species.

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CONCLUSION

In view of the election and arguments presented herein, applicant respectfully requests re-consideration of the restriction requirement and examination of invention on the merits. Applicant requests that the Examiner telephone the undersigned in the event a telephone discussion would be helpful in advancing the prosecution of the present application. The Director is authorized to charge any additional fees or underpayment of fees regarding this response, including extensions for reply, to Deposit Account 07-1509.

Respectfully submitted,

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Dated: November 29, 2005

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